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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,884	03/24/2004	Kevin A. Babiak	SO3589/1/US (6794-000041/	5589
28997	7590	06/12/2006	EXAMINER	
HARNES, DICKEY, & PIERCE, P.L.C 7700 BONHOMME, STE 400 ST. LOUIS, MO 63105			BERNHARDT, EMILY B	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/807,884

Applicant(s)

BABIAK ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-94 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-5,7-11, drawn to a process of making compounds of Formula (1-1) where  $Z3=N$ , classified in class 544, subclasses such as 365,374 and other as may be determined by the nature of substituents thereon.
- II. Claims 1-14, drawn to a process of making compounds of Formula (1-1) where  $Z3=CH$ , classified in class 546, subclasses such as 188,207,etc.
- III. Claim 15, drawn to a process for making compounds of Formula (15-1) and compounds of Formula (17-1) where  $X1=O,S,S(O)$  and  $S(O)_2$ , classified in class 549, subclasses 28,416,etc.
- IV. Claims 15-18, drawn to a process for making compounds of Formula (15-1) and compounds of Formula (17-1) where  $X1=N(Rx1)$ , classified in class 546, subclass 242.
- V. Claims 19-30, drawn to a process for making compounds of Formula (19-1) where  $Z3=N$ , classified in class 544, subclasses 365,374,etc.
- VI. Claims 19-31, drawn to a process for making compounds of Formula (19-1) where  $Z3=CH$ , classified in class 546, subclasses 188, 207.

- VII. Claims 32-33, drawn to a process for making compounds of Formula (32-1) and compounds of Formula (33-1) where  $X1=O, S, S(O), S(O)_2$ , classified in class 549, subclasses 28,416,etc.
- VIII. Claims 32-34, drawn to a process for making compounds of Formula (32-1) and compounds of Formula (33-1) where  $X1=NRx1$ , classified in class 546, subclass 242,etc.
- IX. Claims 35-39,44,46 and 47, drawn to a process for making compounds of Formula (35-1) where  $Z3=N$ , classified in class 544, subclasses 365,374,etc.
- X. Claims 35-47, drawn to a process for making compounds of Formula (35-1) where  $Z3=CH$ , classified in class 546, subclasses 188,207,etc.
- XI. Claim 48, drawn to a process for making compounds of Formula (48-1) where  $Z3=N$ , classified in class 544, subclasses 360,374,etc.
- XII. Claims 48-49, drawn to a process for making compounds of Formula (48-1) where  $Z3=CH$ , classified in class 546, subclasses 188,207,etc.
- XIII. Claims 50-59, drawn to a process for making compounds of Formula (50-1) where  $Z3=N$ , classified in class 544, subclass 365,etc.
- XIV. Claims 50-61, drawn to a process for making compounds of Formula (50-1) where  $Z3=CH$ , classified in class 546, subclass 188,etc.

- XV. Claim 62, drawn to a process for making compounds of Formula (61-1) where  $Z3=N$ , classified in class 544, subclass 365, etc.
- XVI. Claims 62-63, drawn to a process for making compounds of Formula (61-1) where  $Z3=CH$ , classified in class 546, subclass 188, etc.
- XVII. Claims 64-73, drawn to a process for making compounds of Formula (64-1) where  $Z3=N$ , classified in class 544, subclass 365, etc.
- XVIII. Claims 64-73, drawn to a process for making compounds of Formula (64-1) where  $Z3=CH$ , classified in class 546, subclass 188, etc.
- XIX. Claim 74, drawn to a process for making compounds of Formula (74-1) where  $Z3=N$ , classified in class 544, subclass 360, etc.
- XX. Claims 74-75, drawn to a process for making compounds of Formula (74-1) where  $Z3=CH$ , classified in class 546, subclass 188, etc.
- XXI. Claims 76-85, drawn to a process for making compounds of Formula (76-1) where  $Z3=N$ , classified in class 544, subclasses 365, 374, etc.
- XXII. Claims 76-86, drawn to a process for making compounds of Formula (76-1) where  $Z3=CH$ , classified in class 546, subclasses 188, 2-7, etc.
- XXIII. Claim 87, drawn to a process for making compounds of Formula (87-1) where  $Z3=N$ , classified in class 544, subclasses 365, 374, etc.

XXIV. Claims 87-88, drawn to a process for making compounds of Formula (87-1) where  $Z_3=CH$ , classified in class 546, subclass 188,207,etc.

XXV. Claims 89-90,92-93, drawn to compounds of Formula (89-1) where  $Z_3=N$ , classified in class 544, subclasses such as 360,etc.

XXVI. Claims 89-94, drawn to compounds of Formula (89-1) where  $Z_3=CH$ , classified in class 546, subclass 188,etc.

The inventions are distinct, each from the other because of the following reasons: Groups I- XXIV relate to various processes for making not only final products but also starting materials having varying central cores and a variety of substituents thereon. The processes otherwise employ differing reactants based on the reaction transformations and thus would necessitate diverse searches in the process art based on the exact process being conducted. Differing issues of patentability would be expected based at the very least on the Ochiai decision (37 USPQ 2d 1127) in which it was ruled that patentability of process claims is **not only** based on the nature of the reaction but also on the structure of the products and/or reactants employed. Thus art which may render one of the process groups old or obvious would not necessarily do the same for those remaining notwithstanding similar reaction conditions for I/II or III/IV or V/VI,etc. Compounds embraced in XXV and XXVI are not of the same scope as final product(s) produced in Groups XI and

XII and thus art which may anticipate or render obvious one of these groups would not necessarily do the same for the remaining groups.

**In addition to an election of one of the above groups, applicants must further elect a species within the elected group to which claims may be limited should generic claims be found not allowable.**

Because of its length and complexity, the restriction is being set forth in writing.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds

one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


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Application/Control Number: 10/807,884  
Art Unit: 1624

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Emily Bernhardt  
Primary Examiner  
Art Unit 1624